

REMARKS

Claims 1-25 are 35 U.S.C. §103(a) rejected by Morgenthaler in view of Smethers. Examiner relies on Smethers to disclose "a device (300) having a plurality of keys for selecting a function in a **markup language** file (col. 4, lines 38-41). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the function in a **markup language** file as taught by Smethers in the system of Morgenthaler in order to provide additional functions to the device." The specific language in Smethers relied on is as follows:

The browser is a network browser, such as a HTML browser or a HDML browser. The graphical symbols can, for example, be provided as bitmaps JPEG images, or GIF images.

Smethers does not explain clearly what HTML or HDML is, but does mention it again in Col 5. lines 21-25:

Additionally, the client module 212 operates, among other things, a browser, commonly referred to as micro-browser, requiring much less computing power and memory than well-known HTML browsers do.

Smethers seems to clarify the nature of the browser application in col. 10, lines 10-14: "...the group of resident application programs are chosen from the group of: email... and network browser application."

Having said this, it is believed that the Examiner has not shown all elements of claim 1 (and thus for dependent claims 2-9), which includes, among other things **a) reading the markup language file.**

Similarly, it is believed the Examiner has not shown all the elements of claim 10 (and thus for dependent claims 11-16), which includes, among other things **a) reading the markup language file.**

Also, it is believed the Examiner has not shown all the elements of claim 17 (and thus for dependent claims 18-25), which includes, among other things: **a means for reading the markup language file.**

More importantly, even if the Examiner could find another reference (and new ground for rejection) that supplied all the elements of the claims 1, 10 and 17, including, e.g. reading the markup language file, nothing in Smethers seems to suggest that anything special should be done with the markup language file, as Smethers is directed toward objects that are a departure from those in the present invention, thus providing no suggestion or motivation to combine.

Smethers aims to:

- Hence, with the invention, a user is able to efficiently launch the notepad mode of operation (col. 6, lines 11-14);
- Hence, a user is able to efficiently launch the browser mode of operation (col. 6, lines 58-59);
- Hence, a user is able to efficiently launch the address book mode of operation (col. 7, lines 1-2).

The focus of Smethers seems to be entirely on launching of resident applications, and this is even more evident in claims made by Smethers.

Re: claim 16, Examiner raises at the bottom of the Detailed Action page 4, that Smethers teaches, "triggering comprises a step of reading a second markup language file." (col. 7, line 55 to col. 8, line 5 of Smethers). The applicant genuinely struggles to find the specific text in that paragraph that suggests, implies or hints at reading. For clarification, the cited text of Smethers is shown in its entirety below:

Utilizing the present invention, a user desirous of selecting and accessing a resident application on a mobile device, may do so by pressing one of the assigned navigation keys once the device is powered on. This represents a significant contribution to the user friendliness of mobile devices as these device are often used in circumstances where the user is limited to operating the mobile device with a single hand or can not dedicate their full attention to

finding the application they desire. For example, a user attempting to look-up an address in an **ADDRESS book application while busy driving an automobile is able to easily access the ADDRESS book application by pressing an assigned navigation key**. The navigation keys themselves are generally presented in a prominent position on the mobile device so they are easy to find even in poorly lighted environments. Also a readily visible image map is presented on the display screen to provide the user a clear indication as to the identity of the resident applications and the assigned navigation keys. (emphasis added)

More importantly, the Smethers reference appears to teach away from the objectives of the present invention. In particular Smethers is motivated to minimize looking at their device ("cannot devote their full attention"), as the motorist example above suggests. The present invention, however, is directed toward better functioning, **provided that the user is looking at the applicant's device**. So although the present invention, and the prior art devices seem to relate to handheld devices, the motivations and objectives between building the present invention and the prior art inventions are irreconcilable and do not suggest any benefit to combining Morgenthaler with Smethers. Note that the Examiner-cited text stands out prominently relating to claim 16, but that the 'no-look' motivation of Smethers equally shows a purposeful teaching away from the independent claims 1, 10 and 17 as well as all other claims in the present invention.

Provided that the Examiner agrees that Smethers does not provide the missing element, it is respectfully requested that for these reasons, and others already stated, that claim 16 be allowed. Even if the Examiner views Smethers as providing the missing element, it is respectfully requested that Smethers fails to meet the prerequisites of the 35 U.S.C. §103(a) bar, in that no motivation to combine Morgenthaler and Smethers exists.

Given that the above review of the differences of the present invention and the Smethers/Morgenthaler combination is persuasive, the remaining claims in the application (2-9, 11-16 and 18-25) are dependent thereon, and should be allowable. There are many other independent reasons to allow all other claims, as an example please look to the Examiner's comments re: claims 7, 8, 23 and 24, wherein Smethers is supposed to add "triggering a function comprises a step of displaying a card and reading a deck".

Smethers talks about activating, launching and initiating resident applications (see e.g. col. 3 lines 19-22). "...or a HDML browser. The graphical symbols can, for example, be provided as bitmaps, JPEG images, or GIF..." (Col. 4, lines 39-40); "

The deck or card of our invention is not a browser, address book, or an electronic mail, which are the resident applications of Smethers. Thus, claims 7, 8, 23 and 24 escape the 103(a) rejection for reason of Smethers not being able to supply the part that is missing from Morgenthaler. For more details concerning what a card (or deck) is, the Examiner is referred to the specification page 4, lines 5-9.

On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in condition for allowance. Accordingly, reconsideration of this application and allowance of pending claims 1-25 is requested.

Respectfully submitted,

By: Robert C. Rolnik
Robert C. Rolnik
Reg. No. 37,995

Date: 1/22/03